



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,705	06/02/2000	MELVYN LITTLE	35280047US00	8422
27194	7590	03/02/2004	EXAMINER	
HOWREY SIMON ARNOLD & WHITE, LLP			ROARK, JESSICA H	
BOX 34			ART UNIT	
301 RAVENSWOOD AVE.			PAPER NUMBER	
MENLO PARK, CA 94025			1644	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/424,705

Applicant(s)

LITTLE ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 February 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 7, 13, 14 and 21.Claim(s) rejected: 1, 4-6, 9, 12, 19-20, 23-26 and 28.

Claim(s) withdrawn from consideration: \_\_\_\_\_

*Phillip Gambel*  
PHILLIP GAMBEL, PH.D  
PRIMARY EXAMINER  
TECH CENTER 1600  
2/26/04

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 3. Applicant's reply has overcome the following rejection(s):

The previous rejection of claim 4-7, 9, 12-14 and 19-21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The proposed amendment also obviates the previous objection to the specification under 37 C.F.R. 1.821(d).

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's proposed amendment does not add new limitations to the instant claims. While Applicant's arguments regarding the conservation of the CDR3 Cys in other examples of modifications involving the OKT3 antibody are acknowledged, examples of use of the OKT3 antibody without the mutation do not address the motivation provided by the combination of references in the rejection of record. The reduced binding affinity seen after substitution of a Cys in the VH CDR3 of another antibody is also acknowledged. However, as previously noted the instant claims do not require any particular binding affinity and for the reasons of record the Examiner maintains that the motivation and reasonable expectation of success with respect to the recited product and methods existed in the prior art.

Accordingly, the Examiner maintains the following rejections for the reasons of record and the reasons set forth above:

a) Claims 1, 4-6, 9, 12, 19-20, 23-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroon et al. (Pharmaceutica Res. 9:1386-1393 1992, of record) in view of Senoo et al (US Pat. No. 5,852,177, of record) and Kipriyanov et al. (J. Immunol. Meth. 1996; 196:51-62, IDS #4).

b) Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroon et al. (Pharmaceutical Res. 9:1386-1393 1992, of record) in view of Senoo et al (US Pat. No. 5,852,177, of record) and Kipriyanov et al. (J. Immunol. Meth. 1996; 196:51-62, IDS #4) as applied to claims 1, 4-6, 9, 12, 19-20, 23-25 and 28 above, and in further view of Nitta et al. (The LANCET 1990; 335:368-371, IDS #9).

It is noted that claims 7, 13, 14, and 21 are objected to as being dependent upon a rejected base claim, but would appear to be allowable if presented in independent form.